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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,005	09/13/1999	KHAI HEE KWAN		6815

23336	7590	05/21/2007
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EXAMINER	
AUGUSTIN, EVENS J	

ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
05/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/396,005	KWAN, KHAI HEE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Evens Augustin	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13, 14, 26, 33-36, 38-46 and 48-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-14, 26, 33-36, 38-46 and 48-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. The finality of the previous Office action, filed on 20 November 2006, will be withdrawn. If a notice of appeal and the appeal fee set forth in 37 CFR 41.20(b) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant will be construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). In view of 35 U.S.C. 132, no amendment considered as a result of payment of the fee set forth in 37 CFR 1.17(r) may introduce new matter into the disclosure of the application. Claims 13-14, 26, 33-36, 38-46 and 48-52 are pending.

### ***Claim Interpretation***

2. In determining patentability of an invention over the prior art, the USPTO has considered all claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art.
3. It should also be noted that, in the office action that:
  - A. Items in the rejection that are in quotation marks are claimed language/limitations
  - B. Functional recitation(s) using the word “for” or other functional terms (*e.g.* “...for storing executable program code” as recited in claim 34) have been considered but

given less patentable weight<sup>1</sup> because they fail to add any steps and are thereby regarded as intended use language. To be especially clear, the Examiner has considered all claim limitations. However the A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

- C. Word(s) that are separated by “/” are being examined as being synonymous or equivalent
- D. “a database to transfer stored funds” in claim 13, is being interpreted as a database having the ability to transfer stored, and not a database containing stored funds .
- E. The USPTO interprets claim limitations that contain statement(s) such as “*if, may, might, can, could, when, potentially, possibly*”, as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps

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<sup>1</sup> See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

- F. The limitation of “receiving said payee's account identifier and said fund transfer information; upon authenticating the payee's account identifier, instantly crediting the fund to the payee's account if the balance in the database associated with the payer account identifier and password is more than the fund for transfer”, is being interpreted as equivalent to not receiving said payee's account identifier and said fund transfer information; upon authenticating the payee's account identifier, not crediting the fund to the payee's account if the balance in the database associated with the payer account identifier and password is less than the fund for transfer.
- G. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.
- H. Any official notices taken by the USPTO that are not adequately traversed by applicant will be taken to be admitted prior art.
- I. Since the word “database” is not lexicographically defined the USPTO will interpret the word in accordance to Computer Dictionary, 3<sup>rd</sup> Edition, Microsoft Press, Redmond, WA, 1997.<sup>2</sup> Accordingly, a database is database is: n. A file composed of

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<sup>2</sup> Based upon Applicants' disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See *e.g. Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit

records, each containing fields together with a set of operations for searching, sorting, recombining, and other functions. Applicant has not fully disclosed in the specification how a database is to transfer stored funds.

- J. According to Merriam Webster's dictionary, the term "related to " means: to have relationship or connection <the readings relate to his lectures>. The term "concerning" means: characterized by a ready capability to adapt to new, different, or changing requirements <a flexible foreign policy> <a flexible schedule>.
- Accordingly, the term "R is a factor concerning flexibility in currency stored", in claims 26, 36 and 41, is being interpreted as "R is a factor related to a capability to adapt to new, different, or changing requirements in currency stored".

***Claim Rejections - 35 USC § 112 – 1<sup>st</sup> Paragraph***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 13, 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Since the word

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used the *Microsoft Press Computer Dictionary* (3d ed.) as "a technical dictionary" to define the term "flag." See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its

“database” is not lexicographically defined the USPTO will interpret the word in accordance to Computer Dictionary, 3<sup>rd</sup> Edition, Microsoft Press, Redmond, WA, 1997.<sup>3</sup> Accordingly, a database is database is: n. A file composed of records, each containing fields together with a set of operations for searching, sorting, recombining, and other functions. Applicant has not fully disclosed in the specification how a database is to transfer stored funds. All other claims dependent on those above claims are rejected as well.

***Claim Rejections - 35 USC § 112 – 2<sup>nd</sup> Paragraph***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 26, 36 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. As per claims 26, 36 and 41, the applicant recites the term “R is a factor concerning flexibility in currency stored”. The term is being interpreted as “R is a factor related to a capability to adapt to new, different, or changing requirements in currency stored”. In

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appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled ‘New Terminology.’

<sup>3</sup> Based upon Applicants’ disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See *e.g. Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled ‘New Terminology.’

analyzing the stored value equation, the United States Patent Trademark Office has found that the metes and bounds of the claims have not been clearly set forth. Therefore, the claim languages have been held to be indefinite because the intended scope of the claims is unclear. The claims will be interpreted as the value of transferred funds being dependent on the exchange rates and time factor of different countries.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 13-14, 26, 33-36, 38-46 and 48-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Katz et al. (U.S 6424706).
11. As per claims 13-14, 26, 33-36, 38-46 and 48-52, Katz et al. discloses a method and system for purchasing, storing, exchanging, converting, transferring, and otherwise advantageously using prepaid stored value accounts. The computer system/method comprises of the following:



- A. Network such as the Internet, a computer system, a database, a remote input server (col. 8, line 64-67), a plurality of computers (fig. 3A) ("**In an Internet system having a plurality of computers connected by a network, a user to user payment method executable at host server having a database**")
- B. Prompting subscriber/payer for ID and password (col. 17, lines 50-51) ("**prompting payer to input payer's account identifier and password**"), since the system only asks to payer to enter ID and password, password true identity (name, address, and birth date) is not known to the system.
- C. The system includes servers (storage medium necessarily present) (col. 9, lines 58, 64) with proper hardware/software combination (col. 9, lines 49-57, col. 10, lines 1-27)
- D. Validating/authenticating user ID and password (col. 17, lines 51-53) ("**authenticating the said payer's account identifier and password for validity**")
- E. Prompting to enter receiving subscriber/payee ID (col. 17, lines 61-62), and the amount to be transferred (col. 18, lines 6-9) ("**prompting the payer to input payee's account identifier and fund transfer information**")
- F. Receiving the receiving ID and after authenticating the ID (col. 18, lines 10-20), checking sender's account for sufficient funds or minutes being redeemed as local currency (col. 19, lines 49-50) (account has to have at least the amount being sent) (col. 18, line 64) debiting sender's account (col. 18, lines 53), and crediting receiver's account (col. 19, lines 5-6) ("**receiving said payee's account identifier and said fund transfer information**"), ("**upon authenticating the payee's account**")

**identifier, instantly crediting the fund to the payee's account if the balance in the database associated with the payer account identifier and password is more than the fund for transfer ")**

- G. The account in which funds are being transferred from is prepaid stored valued account (col. 4, line 42, )(**"whereby said stored fund is deposited from a prepaid card"**)
- H. The prior art invention makes an electronic funds transfer (col. 8, lines 63-64).  
Therefore the actual transfer is made without any user interaction and regardless of the origination of source fund (**"transfer is made without interacting with said payee and independently of said prepaid card"**)
- I. The prior teaches the receiver's account is good until it is used up (col. 2, lines 25-26) (**"whereby upon completion of storing and linking said prepaid card is valueless "**)
- J. As per claims 26, 36 and 41, the prior art teaches that if the transfer is an international transfer the system branches to a process 462 where the currency exchange handling begins. First, process 462 calculates the value, in the sender's currency, of the unit-minutes about to be transferred. Next, a process 464, in conjunction with a currency exchange rate tables 465, calculates the equivalent value in the receiver's currency. Next, a process 466, using a unit-minute rate tables 467, calculates the number of receiver unit-minutes equivalent to this amount of receiver currency. Finally, a process 468 calculates the exchange rate fees to be assessed to the sender and returns an output data 469 (col. 18, lines 32-43)

- K. Account being accessed or transferred using ATM or merchant POS (col. 7, lines 63, col. 8, lines 2 and 15)
- L. Sending receipt to both the sender and receiver. This message may be sent in a number of formats, including but limited to, voicemail, email, facsimile message (Print) or text page sent to the wireless handset, containing account/transaction ID (col. 19, lines 17-24) ("**printing a receipt representative of a prepaid card having at least a serial number prepaid card and connected to said host server**")
- M. The system uses telephone service (col. 4, line 61, col. 9, line 1) ("**network is a telephone network**")

### ***Conclusion***

12. *Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that if the applicant is preparing to respond, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **Konya (US 5937396)** -The present invention relates to a system for conducting financial transactions and more particularly to a system for transferring currency for disbursement at a remotely located automated teller machine (ATM).
- **Brody (US 5350906)** -This invention relates to currency transfer systems and methods and more particularly to such systems and methods which allow one person, not having a preestablished account to establish within a common account by means of a card having a fixed currency limit thereon, a specified sum of money which can then be removed at a later date either by the same person or by specific other people.
- **Levchin et al. (US 7089208)** -This invention relates to the fields of computer systems and communications. More particularly, a system and methods are provided for facilitating the exchange of value among distributed users through computing devices.

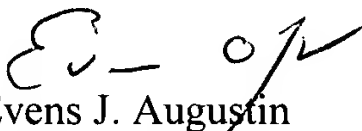
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.
15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779.

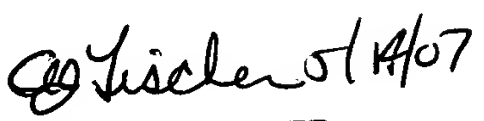
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May 13, 2007  
Art Unit 3621

  
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